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Philipp Stossel

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EXAMINER

WILSON, MICHAEL H

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

1. The Declaration under 1.131 filed 24 April, 2009 will NOT be entered. The declaration has been considered but is ineffective to overcome the Ma et al. (US 6,916,554 B2) reference.

An affidavit or declaration under 37 CFR 1.131 is not appropriate where the reference U.S. patent claims the same patentable invention, see MPEP § 715.05. A 37 CFR 1.131 affidavit is ineffective to overcome a United States patent or patent application publication, not only where there is a verbatim correspondence between claims of the application and of the patent, but also where there is no patentable distinction between the respective claims. *In re Clark*, 457 F.2d 1004, 173 USPQ 359 (CCPA 1972); *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962); *In re Teague*, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); *In re Ward*, 236 F.2d 428, 111 USPQ 101 (CCPA 1956); *In re Wagenhorst*, 62 F.2d 831, 16 USPQ 126 (CCPA 1933).

The cited species of Ma et al. is claimed subject matter in the patent and therefore can not be overcome with a declaration under 37 CFR 1.131. It is also noted that instant formula (I) and the formula of claim 1 in Ma et al. are not patentably distinct from each other.

2. Applicant's arguments filed 24 April, 2009 have been fully considered but they are not persuasive.

Regarding arguments directed to Igarashi et al. (US 2001/0019782 A1) as evidenced by Moore et al. (US 5,484,922), applicants argue that the examiner points to complex 1-31, which allegedly "demonstrates" that a cyano group is also a "suitable" substituent for the phenyl ring of complex 1-1, and concludes that the skilled artisan would reasonably expect that such substitution of complex 1-1 would result in a compound "with similar properties suitable for the same purpose" and argues that the examiner provides no basis in Igarashi et al. or in the prior art for this conclusion. However the examiners conclusions as set forth in the rejection of record are clearly based on the explicit and implicit teaching of the cited prior art and applicant fails to present evidence supporting the argument that one of ordinary skill would not expect the modified complex to possess similar properties and be suitable for the same purpose.

Applicants further argue that Igarashi et al. is silent as to the performance of complex 1-31 relative to its unsubstituted analog, complex 1-23, and argues that without such comparative performance data, the skilled artisan is unable to assess what benefit, if any, can be derived from phenyl ring substitution of complex 1-23 with a cyano group and, thus, has no motivation to analogously substitute the phenyl group of complex 1-1. However the mere fact that Igarashi et al. does not present data on some of the disclosed complexes does not negate the disclosure of their suitability or render obvious variants non-obvious. Further, the effect of cyanide as a substituent on ligands in metal complexes is very well known and studied in the art. One of ordinary skill in the art would readily understand that cyanide is an electron withdrawing substituent and would

readily expect cyanide to affect a metal complex in the manner consistent with an electron withdrawing substituent.

Applicant also argues regarding Hammett constants that it is generally known to the skilled artisan that Hammett constants are not predictive where direct resonance interaction with the aryl ring is possible. Applicants note that, in the case of cyano groups, direct resonance interaction is possible only in the para position, not in the meta position. As such, the skilled artisan would not recognize a para substituted cyano group to be "equivalent" to a meta substituted cyano group. Furthermore, even assuming arguendo that art- recognized equivalence existed, Applicants submit that the skilled artisan would have no motivation to "ring walk" the meta substituted cyanide to the para position, since no improvement in properties would be anticipated as a result of the alleged "equivalence" of these two positions. However the introduction of resonance does not negate the basic fundamental nature of the substituent. The fact that cyanide is an electron withdrawing substituent as shown by the Hammett value is not negated by resonance. One of ordinary skill in the art would readily appreciate cyanide as electron withdrawing even though the exact value may not be the same due to resonance. Similar does not mean identical. Further the term "equivalent" in this context is used to describe compounds/positions with similar properties and effects suitable for the same purpose. Applicants have failed to show why one of ordinary skill would not reasonably expect a cyanide in the para position to result on a similar complex with similar properties suitable for the same purpose. Nor have applicants resented evidence of unexpected results. Further the standard for obviousness under

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103 is not the expectation of superior results, but the expectation of similar results.

Applicants appear to be arguing the criticality of cyanide in the para position but do not present any evidence of such a criticality, nor have applicants present evidence supporting any significant difference between the properties of cyanide in the meta and para substitutions.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL WILSON whose telephone number is (571) 270-3882. The examiner can normally be reached on Monday-Thursday, 7:30-5:00PM EST, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/

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Supervisory Patent Examiner, Art Unit 1794

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